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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,361	07/06/2005	Yoshinobu Sato	37808-0011	3251

26474 7590 04/23/2007

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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/541,361	SATO ET AL.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/27/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 15-23 are pending. Claims 1-14 have been canceled. Applicant's amendment and arguments filed 12/27/06 have been entered.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 9/26/07 have been withdrawn:

The rejection of claims 16-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP11-180836, JP11-323380, JP7-331281, or JP11-323378. Note that, a translation of each document has been received and included with this Office action.

'836 teaches a cosmetic, compatible with hair when applied containing 0.01 to 10% by weight of N-acylamino acid wherein the acyl chain contains from 8 to 22 carbon atoms, from 0.001 to 10% by weight of a neutral amino acid such as glycine, and as required, a nonionic surfactant. See Abstract. Specifically, '836 teaches compositions having a pH of 5.2.

'281 teaches a detergent composition containing an N-acylglycine or its salt (preferably having an acyl group of a palm kernel oil fatty acid or an acyl group of a coconut oil fatty acid) and one or more kinds of substances selected from an amino acid and a saccharide. The pH of the composition is from 6.5 to 9. See Abstract.

'380 teaches a solid detergent composition containing one or more N-acylamino acid salts selected from N-acylglycine, N-acylalanine, and N-acylbeta-alanine and one

or more selected from acidic amino acids and salts thereof. See Abstract. The pH of the composition is from 5 to 7. See column 1, lines 10-40.

'378 teaches a solid detergent composition containing at least one anionic surfactant selected from salts of N-acylamino acid, salts of acylisethionic acid, and salts of alkylsulfosuccinic acids; at least one wax; and at least one compound selected from acidic amino acids and salts thereof. The pH of the composition is from 5 to 7. See column 1, lines 20-50.

Note that claim 15 is a product-by process claim; the Examiner asserts that the N-acylamino acid surfactants and amino acid salts contained within the detergent compositions specifically taught by '836, '281, '380, or '378 will mix when used and inherently form the same surfactant as recited by the instant claims. '836, '281, '380, or '378 disclose the claimed invention with sufficient specificity to constitute anticipation.

Note that, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product n the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing to be substantially identical is found a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious result. See MPEP 2113.

Accordingly, the broad teachings of '836, '281, '380, or '378 anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of '836, '281, '380, or '378 are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to formulate a surfactant composition having the same properties as recited by the instant claims because '836, '281, '380, or '378 teach that the types and amounts of components added to the composition may be varied.

Claim 23 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP11-180836 or JP7-33128. Note that, a translation of each document has been received and included with this Office action.

'836 and 281 are relied upon as set forth above.

Note that claim 23 is a product-by process claim; the Examiner asserts that the N-acylamino acid surfactants and amino acid salts contained within the detergent compositions specifically taught by '836 or 281 will mix when used and inherently form the same surfactant as recited by the instant claims. '836 or 281 disclose the claimed invention with sufficient specificity to constitute anticipation.

Note that, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product n the product-by-process claim is the same as or obvious from a product of the prior art,

the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing to be substantially identical is found a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious result. See MPEP 2113.

Accordingly, the broad teachings of '836 or '281anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of '836 or '281 are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to formulate a surfactant composition having the same properties as recited by the instant claims because '836 or '281 teach that the types and amounts of components added to the composition may be varied.

Claims 15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagashima et al (US 4,273,684).

Nakashima et al teach a transparent detergent bar possessing good forming power and detergency in hard water which is formulated consisting essentially of at least one salt of a N-long chain acyl-optically active acidic amino acid neutralized with a basic amino acid in the ratio of 1 mol of the former to 1 to 2 mols of the latter and water in the range of 5 to 35% based on the weight of the bar apart from water. Other adjuvants may be present. The pH value of the resultant composition is, for example, 5. See Abstract and column 5, line 40 to column 6, line 40. Nakashima et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Nakashima et al anticipate the material limitations of the instant claims.

Response to Arguments

With respect to '836, Applicant states that '836 concerns a N-acylamino acid with a neutral amino acid such as glycine, and as required, a nonionic surfactant while the instant claims do not require the use of a nonionic surfactant and require another amino acid which is different from that taught by '836. In response, note that, the instant claims do not exclude the use of a nonionic surfactant as taught by '836. Additionally, '836 teaches the use of glycine which is the same the amino acid recited by instant claims 18 and 21.

With respect '261, '380, or '378, Applicant states that the claimed invention is not simply a mixture of a long chain acyl amino acid with another amino acid and at best, the prior art concerns these other ionic forms or mixtures with such forms as minor ingredients. Further, Applicant states that the claimed invention, on the other hand, concerns a specific cation of the long chain acyl amino acid with an anion of the other, otherwise no good lathering results. In response, note that, the Examiner maintains that the instant claims simply require an ion-pair surfactant salt of an acylamino acid and alkali salt of an amino acid which is formed by blending the two components together. Further, the Examiner maintains that '261, '380, or '378 teach blending an acylamino acid and alkali salt of an amino acid, which is the same as recited by the instant claims, and that an ion pair surfactant would inherently form from such a mixture of the two components. Applicant has provided no evidence or data to show that the compositions

taught by the prior art are any different from the compositions recited by the instant claims and thus, the rejection of the claims under 35 USC 102 has been maintained. Additionally, note that, while Applicant has generally pointed to different parts of the specification as showing unexpected and superior properties of the claimed invention, such evidence is not sufficient to overcome any rejection under 35 USC 102. Alternatively, even if the prior art is not sufficient to anticipate the instant claims under 35 USC 102, which the Examiner is clearly not conceding, the Examiner asserts that Applicant has not pointed specifically or clearly as to which data is being relied upon and how this data shows the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the instant claims.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 10/27/06 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD